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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/308,451	05/19/1999	ROBERT G. SCHWARTZ	8001.104/00	6174
7590 09/07/2004			EXAMINER	
CLARENCE A. GREEN PERMAN & GREEN, LLP 425 POST ROAD FAIRFIELD, CT 06430			RIMELL, SAMUEL G	
			ART UNIT	PAPER NUMBER
			2175	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/308,451

Applicant(s)

SCHWARTZ ET AL.

Examiner

Sam Rimell

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,10-13,17-21,24-33,40-44,89-102 and 106 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,10-13,17-21,24-33,40-44,89-102 and 106 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

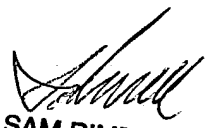
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.


SAM RIMELL
PRIMARY EXAMINER

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-7, 10-13, 17-21, 24-33 and 89-102 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz et al. (US Patent Application Publication 2002/0073040).

Applicability of Schwartz et al. as prior art: The reference to Schwartz et al. meets the requirements for prior art under 35 USC 102(e)(1). The reference is a patent application publication; it is filed by another (it includes inventors not in common with the present application--- see MPEP 2136.04); and the critical reference date is a provisional application in the priority claim of the publication (See MPEP 2136.03, Section III). This provisional application cited in Schwartz et al. has a filing date of April 23, 1996, which precedes applicant's priority claim of September 22, 1997. The reference is therefore applicable as prior art under 35 USC 102(e).

Claim 1: FIG. 8 illustrates a data structure in the form of a plurality of postal data elements. These data elements are processed by the mail processing apparatus (150). A first data element is the digital signature (801i). A second data element is the postal data block (801h). Each of the first data element (801i) and second data element (801h) are bar coded (paragraph 0061, lines 102) so they must define first and second bar coded elements.

Since the first and second data elements are discrete fields, (paragraph 0061, lines 1-2 and FIG. 8), they must inherently be separated by field delimiters in order to define discrete fields.

The first data element (digital signature) is a function of the second data element (postal data) in the sense that the first data element (digital signature) is not created and cannot be created until all of the other data elements are created. The digital signature is based on all the previous data elements (page 6, paragraph 0069). As seen in FIG. 8, the second data element (postal data) precedes the first data element (digital signature). The printer (190) is the output for providing a representation (FIG. 7) representing the data elements.

Claim 4: The barcode (710) is a data matrix symbol.

Claim 5: The second data element (postal data) pertains to a postage value while the first data element is related to a descending register (see page 3, first paragraph on page).

Claim 6: The barcode (710) is also a bitmap of encoded symbols.

Claim 7: FIG. 8 illustrates a plurality of postal elements. The block 801(h) (postal data) can be designated as the “second data element”. Each block preceding the second data element is independent of that data element. The printer (190) is the output which prints out a representation (FIG. 7) of the postal data element. The postal elements correspond to bar code in FIG. 7. Each data element is inherently separated by a field delimiter.

Claim 10: See remarks for claim 4.

Claim 11: See remarks for claim 5.

Claim 12: See remarks for claim 6.

Claim 13: FIG. 8 illustrates a first subset of data (801a) and a second subset of data (801c). The first subset of data is unaffected by the transaction since it can be repeatedly used. The second subset of data can change with each transaction. These subsets closely correspond to the “fixed” and “variable” subsets of data described by applicant in page 11, lines 19-28 of the specification.

Each of the subsets of data (801a) and (801c) are bar coded into the bar code of FIG. 7. Since each subset of data defines a discrete field, the fields are inherently separated by field delimiters.

Claim 17: See remarks for claim 4.

Claim 18-19: Both the first subset of data and second subset of data are applied as bar codes.

Claim 20: See remarks for claim 13.

Claim 21: Since the first subset of data can remain constant, it remains generated before the second subset, which can change for each transaction. It is also noted that this claim is directed more to a method step than the physical structure of an apparatus, and thus it is alternatively held that the features of this claim will not carry patentable weight, since they are not limitations of the physical structure of the apparatus

Claim 24: See remarks for claim 4.

Claim 25: The output includes a printer (190).

Claim 26: The first data is a digital signature, such shown in FIG. 8. The “predicted second data” is the table of rates and mail classes (paragraph 0025) stored in storage device (156). The “actual second data” is data input by the user regarding the characteristics of the

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package, such as the weight and delivery zip code (steps 430-450 in FIG. 4). The processor compares the predicted second data with the actual second data and then generates the digital signature (first data) and postal indicium carrying that signature.

Claims 27-28: The predicted second data concerns postage values and mail classes.

Claim 29: The predicted second data are statistics in a memory table.

Claim 30: The predicted version of the second data is a set of postage values and can be any value.

Claims 31-32: The first value is an authenticating code or digital signature.

Claim 33: The processor includes software for making the comparison between the predicted second data and actual second data.

Claim 89: Schwartz et al. includes a printer (190).

Claim 90: FIGS. 3A and 3B of Schwartz et al. illustrate a mail piece having the indicia.

Claim 91: In FIGS. 3A and 3B, the indicia is on the mail piece.

Claim 92: See remarks for claim 89.

Claim 93: See remarks for claim 90.

Claim 94: See remarks for claim 91.

Claim 95: See remarks for claim 89.

Claim 96: See remarks for claim 90.

Claims 97-100: See remarks for claim 91.

Claim 101: See remarks for claim 89.

Claim 102: See remarks for claim 90.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-44 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilham (U.S. Patent 5,200,903) in view of Official Notice.

Claim 40: Gilham discloses a printer (22) having two separate print heads (28) and (31).

The print head (28) is used to print the postage mark which includes a bar code to the right of the postage indication. The print head (31) prints an address.

While Gilham specifically does not show the printing of a bar code, Examiner takes Official Notice that it was well known in the art at the time of the invention to print a bar coded version of the zip code underneath the printed numerical version of the zip code, to facilitate zip code reading by postal service systems.

Accordingly, it would have been obvious to one of ordinary skill in the art to modify Gilham so as to print a zip code beneath the printed zip code on the envelope, so as to facilitate reading of the zip code by postal system machinery as was well known in the art at the time of invention.

By such combination, Gilham discloses a first print head (28) that prints a first bar code and second print head (31) that prints a second bar code. The delimiter is the space between the print heads and the spacing between the bar codes is at least greater than the size of the delimiter.

Claim 41: The symbol (29) is a data matrix symbol.

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Claims 42-43: The symbol (29) may be considered either “dark on light” or “light on dark” since the claims do not specify which item is light and which item is dark. Thus, these two terms only suggest that some contrast exists.

Claim 44: The “finder pattern” is the bode code itself, based on applicant’s description in the specification. The field delimiters that separate the fields of FIG. 8 would be defined in the bar code.

Claim 106: The envelope is a medium having a postal indicia thereon.

Remarks

Applicant’s arguments have been considered.

With respect to claim 1, Applicant argues that Schwartz et al. does not disclose separated first and second bar code elements. Examiner maintains that FIG. 8 illustrates first and second discrete fields of data. Since these fields are bar coded in FIG. 7, they must represent first and second bar codes.

With respect to claim 26, applicant argues that Schwartz et al. does not teach a predicted version of second data. Examiner maintains that the stored data pertaining to mail rates and mail classes is a predicted version of data. It is observed that this claim is not addressed to a method of prediction, but rather, the mere presence of a static set of predicted data that is available to the processor. A set of data pertaining to mail rates and mail classes would be a set of such static data available to processor.

Applicant argues that Schwartz et al. fails to teach the presence of delimiters. Examiner maintains that since FIG. 8 illustrates discrete fields, they must inherently be separated by field delimiters.

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Applicant's arguments for claims 40-44 and 106 are moot in light of the new grounds of rejection, necessitated by the amendment.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
Art Unit 2175